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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,399	11/28/2001	Bruce McGarian	66455-202-5	9414

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,399

Applicant(s)

MCGARIAN ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2313391 in view of Braddick (US 5,595,247).

Regarding claims 16 and 17: GB 2313391 discloses a whipstock casing milling system. The system includes the following features:

- A whipstock (44) with a whipface (46).
- A first ramp surface (see Figure 4) and a second ramp surface (46) that meets the first ramp at a junction. The first ramp is relatively steep compared to the second ramp surface relative to the longitudinal axis of the whipstock so that the first ramp is disposed at a greater angle to the longitudinal axis than the second ramp.
- A window mill (32) operable to form an opening in wellbore casing (9). The milling elements of the mill engage the first ramp and are deflected by that ramp laterally into the casing. (See Figure 4) The mill is attached to the whipstock by a securing means (39).

GB 2313391 discloses all of the limitations of the above claims except for a protrusion extending from the first ramp.

Braddick teaches a whipstock that includes a protrusion (260) located on the whipface (254). The protrusion is an extension of the first ramp and together they form a mill-deflecting slope. As recited in column 14, lines 54-56, the protrusion will be partially milled off during the milling operation thus the protrusion will reduce the damage to the first ramp at the junction of

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the first and second ramp. The protrusion would also move the milling elements past the first ramp thus reducing the stress on the first ramp and the whipstock.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the protrusion of Braddick on the whipstock of GB 2313391 in order to have protected the whipstock from being damaged (see col. 14, lines 40-58).

Regarding claim 18: As seen in Figures 8 and 9 of Braddick, the protrusion is located on the second ramp.

Regarding claims 19 and 20: The means for securing is a shear bolt (see page 13, lines 15-27). The examiner notes that it is well known in the art that bolts are a threaded fastener.

Regarding claim 21: As seen in Figures 8 and 9 of Braddick, the protrusion includes a surface that is ramped at the same angle relative to the longitudinal axis of the whipstock as the first ramp.

Regarding claim 22: As seen in Figure 4, the angle of the first ramp surface is 15° relative to the longitudinal axis of the whipstock.

Response to Arguments

3. In view of applicant's amendment, the objection to claim 17 as well as the 35 USC 112(2) rejection of claim 16 has been withdrawn.

4. In response to applicant's argument that the milling elements of the mill of Braddick do not engage the first ramp, the examiner agrees and the rejection of claim 16-22 with Braddick as the primary reference has been withdrawn.

5. Applicant's arguments filed 7 October 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that GB 2313391 discloses a one-trip system but the system damages the first ramp, the examiner agrees but notes that she has relied upon Braddick to teach a protrusion that is an extension of the first ramp thus protecting the first ramp (see col. 14, lines 40-58 of Braddick).

In response to applicant's argument that the present invention has the advantages of Braddick and GB 2313391 without the disadvantages of each, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the nose of Braddick is the primary wear reducing feature not the protrusion, the examiner agrees but notes that Braddick has been relied upon merely for the teaching of the protrusion and the advantages for using such a feature.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to coming GB 2313391 and Braddick can clearly be found in column 14, lines 40-58 of Braddick.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

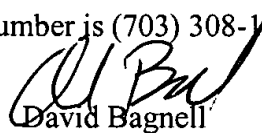
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

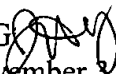
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG 
November 3, 2003